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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,420	06/23/2003	Tomohiko Kikuchi	WISEL 20.401	1990

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EXAMINER	
DANIELSEN, NATHAN ANDREW	
ART UNIT	**PAPER NUMBER**
2627	

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/602,420	KIKUCHI, TOMOHIKO	
	Examiner	Art Unit	
	Nathan Danielsen	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4 and 5* is/are rejected.

7)☒ Claim(s) *3* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 June 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-5 are pending.

Claim Objections

2. Claims 2 and 4 are objected to because of the following informalities: the examiner suggests changing "comprising" to --comprises-- or --further comprises--. Claim 2 is further objected to because Applicant has removed the phrase "or a disk similar thereto" from claim 4 and should do the same in claim 2. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ford (UK Patent Application GB 2361348).

Regarding claim 1, Ford discloses a digital audio data reproducing system comprising (whole of disclosure):

a digital audio data reproducing apparatus including a recording medium in which digital audio data are stored, detection means for detecting the digital audio data stored in said recording medium and a processing section for reproducing said digital audio data in accordance with a reproducing speed signal and a reproducing direction signal which are supplied from the outside to said detection means (page 1, ¶s 2, 3, and 9);

an analog record player including a turntable for an analog record or a disk similar thereto and rotation driving means for said turntable (¶ 4 and figure 1); and

a rotation detecting apparatus mounted onto said analog record player for detecting both the speed of revolution and the sense of rotation for either said turntable or said analog record or a disk similar thereto, which is rotated by said turntable, and for supplying said reproducing speed signal and said reproducing direction signal to said digital audio data reproducing apparatus, after determining said reproducing speed signal and said reproducing direction signal from the detection signals for the speed of revolution and the sense of rotation (¶ 4 and figures 1 and 2).

Regarding claim 2, Ford discloses a digital audio data reproducing system according to claim 1, wherein said rotation detection apparatus comprises:

a rotation body (the platter of the turntable of the record deck in figure 1) which is rotated by either said turntable or said analog record in contact therewith (¶ 8); and

a rotary encoder (encoded dummy record A including the pattern of reflective and non-reflective areas A1 in figure 2 and ¶ 8) including an encoder disk connected to a rotary shaft of said rotation body and a photoelectric detector for sensing said encoder disk.

Regarding claim 4, Ford discloses a digital audio data reproducing system according to claim 1, wherein said rotation detecting apparatus comprising:

an image sensor (record movement sensor B in figures 1 and 2) for reading the surface of said analog record as image data (the reproduction of the pattern A1 inherently constitutes creating a linear image of the reflective and non-reflective areas of pattern A1); and

a processing unit for determining said reproducing speed signal and said reproducing direction signal to be output on the basis of said image data supplied from said image sensor (¶ 9).

Regarding claim 5, Ford discloses a digital audio data reproducing system according to claim 4, wherein said rotation detecting apparatus is further equipped with switch means for

transmitting/interrupting said reproducing speed signal and said reproducing direction signal to said digital audio data reproducing apparatus by the operation of an operator at the output of said processing unit in said rotation detecting apparatus (¶ 12 where the transmitting/interrupting of the signals is based on the lack of signals to be reproduced).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,898,165 (hereinafter Kikuchi '165) in view of Spencer (US Patent 6,881,949).

Regarding claim 1, Kikuchi '165 claims a reproducing system comprising:

a reproducing apparatus including a recording medium, detection means for detecting audio data, and a processing section for reproducing said audio data;

an analog record player including a turntable and rotation driving means for said turntable; and

a rotation detecting apparatus which is rotated by said turntable and supplies a reproducing speed signal and a reproducing direction signal to said audio data reproducing apparatus (all limitations found in claim 1).

However, Kikuchi '165 does not claim where the reproducing apparatus reproduces *digital* audio data from a *digital* recording medium.

In the same field of endeavor, Spencer discloses an apparatus for providing a user with control over audio and video digital media via an analog control unit capable of playing existing vinyl records. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have controlled digital audio reproduction by manipulating a vinyl record, as taught by Spencer, for the purpose of synchronizing a vinyl record with a digital source (col. 1, lines 57-64).

Regarding claim 2, Kikuchi '165 claims a digital audio data reproducing system according to claim 1, wherein said rotation detection apparatus comprises:

a rotation body which is rotated by either said turntable or said analog record or a disk similar thereto in contact therewith; and

a rotary encoder including an encoder disk connected to a rotary shaft of said rotation body and a photoelectric detector for sensing said encoder disk (all limitations claimed and described in claims 1 and 4).

Allowable Subject Matter

7. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

Claim 3 is allowable over the prior art of record because all references, considered as closest prior art and viewed individually or in combination, fail to teach or fairly suggest "supporting means for changing said rotation body and said rotary encoder from a first position at which said rotation body and said rotary encoder is in contact with said analog record or a disk similar thereto to a second position at which said rotation body and said rotary encoder is away from said analog record or a disk similar thereto and vice versa by the operation of an operator" as recited in claim 3.

Citation of Relevant Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Spencer discloses two embodiments of an apparatus which use a rotary encoder and an image analysis technique, independently and without means to switch either off, to determine the rotational speed and direction of an analog (vinyl) record;

b. Jukes (UK Patent Application GB 2405686) discloses a record deck interface for the manipulation of digital audio files comprising a rotational encoder connected to a rotation surface of the record deck and used to determine the rotational speed and direction of the turntable; and

c. Inoue et al (US Patent Application Publication 2004/0190409) discloses the rotary encoder, as well as its operation and placement on the record deck, of the instant application.

Response to Arguments

10. Applicant's arguments, see pages 6-8, filed 29 March 2006, with respect to the rejection(s) of claim(s) 1 and 2 under 35 USC § 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ford, as shown above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Danielsen whose telephone number is (571) 272-4248. The examiner can normally be reached on Monday-Friday, 8:30 AM - 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A.L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nathan Danielsen ND
05/17/2006

THANG V. TRAN
PRIMARY EXAMINER